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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,688	06/06/2005	Min Kyun Na	428.1054	8393
7590 Michael N. Mercanti Lucas & Mercanti 475 Park Avenue south New York, NY 10016		06/18/2007	EXAMINER MELLER, MICHAEL V	
			ART UNIT 1655	PAPER NUMBER
			MAIL DATE 06/18/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/537,688

Applicant(s)

NA ET AL.

Examiner

Michael V. Meller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 12 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election of Group I, claims 1-11 in the reply filed on 3/26/2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 12 and 13 are withdrawn from further consideration as being drawn to non-elected subject matter.

The restriction requirement is still deemed to be proper thus it is made FINAL.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1, 2, 7, 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Ma et al. or Li et al.

Ma teaches that cercis chinensis is extracted with 95% EtOH, see abstract.

Li teaches that Cercis chinensis is extracted with ethanol as well, see abstract.

Claims 1, 2, 5, 7, 8, 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Kim et al et al.

Kim teaches that cercis chinensis is extracted with MeOH and that myricitrin and gallic acid are in the cercis cinensis extract, see abstract.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1, 2, 5-8, 10, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over CN 1294926 in view of Kim et al. and further in view of JP 61200922 and Ingenta connect.

CN teaches that Chinese redbud (same as *cercis chinensis*) is used to treat angina pectoris and is in capsule form, see abstract.

CN does not teach that the extract is in tablet form, that is extracted with ethanol or methanol or that *cercis chinensis* inherently has piceatannol, myricitrin and gallic acid in it.

Kim teaches what is above.

Jp teaches that tablets and capsules are common alternates for different forms of a plant extract to be administered in, see abstract.

Ingenta connect teaches that piceatannol is in the *cercis chinensis* extract inherently, see abstract.

Thus it would have been obvious to extract *cercis chinensis* with methanol since Kim makes it clear that the plant is commonly extracted with methanol and phenolic compounds can be isolated therefrom. Further it is obvious to use tablet form instead of capsule form of CN since JP makes it clear that tablets and capsules are interchangeable in the plant extract art for being both desirable forms of oral administration. Ingenta connect simply makes it clear that piceatannol is also inherently in *cercis chinensis*.

The result-effective adjustment in conventional working parameters (e.g., determining an appropriate amount of the components within the composition-

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piceatannol, gallic acid and myricitrin) is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan. Although the amounts are seen as inherent, in the event they are not inherent to the composition then for the above reasons it would have been obvious to use the claimed amounts for the above reasons.

Claims 1, 2, 5-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over CN 1347705 in view of Kim et al. and further in view of JP 07138175 and ingenta connect.

CN teaches that Chinese redbud (same as *cercis chinensis*) is used as a medicinal liquid and is in liquid form, see abstract.

CN does not teach that the extract is in powder or tablet form, that is extracted with ethanol or methanol or that *cercis chinensis* inherently has piceatannol, myricitrin and gallic acid in it.

Kim teaches what is above.

JP teaches that tablets, liquids and powders are common alternates for different forms of a plant extract to be administered in, see abstract.

Ingenta connect teaches that piceatannol is in the *cercis chinensis* extract inherently, see abstract.

Thus it would have been obvious to extract *cercis chinensis* with methanol since Kim makes it clear that the plant is commonly extracted with methanol and phenolic compounds can be isolated therefrom. Further it is obvious to use tablet or powder form instead of liquid form of CN since JP makes it clear that tablets, liquids and powders are common alternates for different forms of a plant extract to be administered in. Ingenta connect simply makes it clear that piceatannol is also inherently in *cercis chinensis*.

The result-effective adjustment in conventional working parameters (e.g., determining an appropriate amount of the components within the composition- piceatannol, gallic acid and myricitrin) is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan. Although the amounts are seen as inherent, in the event they are not inherent to the composition then for the above reasons it would have been obvious to use the claimed amounts for the above reasons.

Claims 1-4, 7, 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over CN 1347705 in view of Ma et al. and further in view of JP 07138175.

CN teaches that Chinese redbud (same as *cercis chinensis*) is used as a medicinal liquid and is in liquid form, see abstract.

CN does not teach that the extract is in powder or tablet form or that is extracted with 60 % ethanol.

Ma teaches what is above.

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Jp teaches that tablets, liquids and powders are common alternates for different forms of a plant extract to be administered in, see abstract.

Thus it would have been obvious to extract *cercis chinensis* with ethanol since Ma makes it clear that the plant is commonly extracted with 95 % ethanol. Further it is obvious to use tablet or powder form instead of liquid form of CN since JP makes it clear that tablets, liquids and powders are common alternates for different forms of a plant extract to be administered in.

The result-effective adjustment in conventional working parameters (e.g., determining an appropriate amount of the ethanol to use) is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael V. Meller whose telephone number is 571-272-0967. The examiner can normally be reached on Monday thru Thursday: 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Michael V. Meller  
Primary Examiner  
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